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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,521	04/25/2005	Anthony William Denne	7063.204-US	6025
23650 7590 01/27/2010 NOVO NORDISK, INC. INTELLECTUAL PROPERTY DEPARTMENT 100 COLLEGE ROAD WEST PRINCETON, NJ 08540				
EXAMINER WITCZAK, CATHERINE				
ART UNIT		PAPER NUMBER		
3767				
NOTIFICATION DATE		DELIVERY MODE		
01/27/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/532,521

Applicant(s)

DENNE, ANTHONY WILLIAM

Examiner

CATHERINE N. WITCZAK

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-10, 12 and 21- 23, 27 and 28 is/are rejected.
- 7) ☒ Claim(s) 2, 11, 13-20 and 24-26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's arguments, see Response, filed 8/26/09, with respect to the election/restriction requirement have been fully considered and are persuasive. The election/restriction requirement of the claims has been withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 5-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5-9 recite the limitation "the spring". There is insufficient antecedent basis for this limitation in the claim. Claims 5-9 are all dependent from claim 4. While claim 4 mentions a spring, as the claim is currently worded, the spring member is not positively recited (the claim simply requires a mass that can be accelerated by a spring member), and thus does not provide sufficient antecedent basis for claims 5-9.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. Claims 1, 3, 4, 10, 12, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen (US 2,912,791) as modified by Kwan (US 2002/0111109).

Cohen discloses in Figure 1 an injector comprising a rigid tube (29) with a nozzle outlet (14) at one end and a non-return valve (24) at the other; a hole (31) in the tube wall; a liner (12); a mass (27) bearing a piston (28) capable of being accelerated to impact the liner; and the mass being capable of being accelerated by a spring. Cohen discloses the claimed invention except for expressly disclosing the liner being made of silicone rubber comprising a proportion of silicone oil. Kwan teaches in paragraph [0015] that it is known to use polysiloxane resins in constructing inflatable articles. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the device of Cohen with the teaching of Kwan by using polysiloxane resins in the liner since such a modification would enhance the ability of the device to maintain its shape after continuous use.

Cohen as modified by Kwan discloses the claimed invention except for expressly disclosing the mass being triangularly shaped. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the shape of the tip of the mass (27) of the device of Cohen so as to come to a point (as opposed to being rounded as currently shown) because Applicant has not disclosed that a triangularly shaped mass provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the rounded tip of the mass of Cohen because both the rounded tip as shown and a triangularly shaped mass would provide for a pivot point about which lever (33) could pivot so as to successfully and easily use the device. Therefore, it would have been an obvious matter of design choice to modify Cohen to obtain the invention as specified in claim 10.

3. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen as modified by Kwan in further view of Larin (US 2,802,298).

Cohen as modified by Kwan disclose the claimed invention except for the device comprising a low rate retractor spring. Larin discloses in Figure 2 an injection device comprising a low rate retractor spring (21). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the device of Cohen as modified by Kwan with the teachings of Larin, since such a modification would make the device easier to use and would also put well stress on the liner when the device is not in use.

Allowable Subject Matter

Claims 2, 11, 13-20, and 24-26 (as well as claims 4-9 assuming that the recitation of a spring member in claim 4 is changed so as to include a positive recitation of a spring member) are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CATHERINE N. WITCZAK whose telephone number is (571)272-7179. The examiner can normally be reached on Monday through Friday, 8-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Catherine N Witczak/
Examiner, Art Unit 3767